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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062064
Party	Defendant Younique
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Attachments	ANSWER & COUNTERCLAIMS.pdf(1105821 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MARK M. YOUSSEF,	x	
	:	
Petitioner and Counterdefendant,	:	
	:	Cancellation No. 92062064
v.	:	
	:	Reg. No.: 4,504,512
YOUNIQUE, LLC,	:	
	:	Mark: YOUNIQUE PRODUCTS & Design
Registrant and Counterclaimant.	:	
	x	

REGISTRANT’S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS

Registrant Younique, LLC (“Registrant” or “Younique”) hereby files the following Answer, Affirmative Defenses, and Counterclaims in response to the Petition for Cancellation (the “Petition”) filed by Mark M. Youssef (“Petitioner” or “Dr. Youssef”).

PRELIMINARY STATEMENT

Dr. Youssef’s allegation that Younique’s YOUNIQUE PRODUCTS & Design mark is confusingly similar to Dr. Youssef’s YOUNIQUE mark has no merit. The United States Patent & Trademark Office (“USPTO”) agrees, and that is why the USPTO registered Younique’s mark without ever citing Dr. Youssef’s registration for the YOUNIQUE mark to which Dr. Youssef alleges ownership in Paragraph 1(b) of the Petition; that registration issued before Younique applied for the YOUNIQUE PRODUCTS & Design mark covered by this cancellation proceeding.

Not only that, but Dr. Youssef himself previously represented to the USPTO that there is no likelihood of confusion here. In connection with his own prior application for the YOUNIQUE mark (a now-abandoned application not cited in the Petition), Dr. Youssef unequivocally represented to the USPTO as follows:

In this regard, it should be recognized that the applicant herein [Dr. Youssef] is a medical doctor (as indicated on the applicant’s trademark specimen filed with this application). The applicant’s medical services are very specialized

treatment services of the type that would be administered by a doctor or a licensed practitioner who is skilled in administering such services. Moreover, the applicant's medical services will be performed at a particular medical facility (e.g., a doctor's office, clinic, etc.) that is associated with a medical practice.

On the other hand, the (non-medicated) cosmetics of the registrant would not typically be distributed by or associated with any particular medical doctor or medical practice. What is more, a medical doctor or licensed practitioner is usually not required to administer the registrant's cosmetics. In fact, the registrant's cosmetics would be expected to be sold from a drugstore, convenience store, supermarket, or the like, rather than from a particular medical facility like that from which the applicant's treatment services are administered and from which care would be offered to a patient during and following treatment.

Accordingly, it is submitted that the nature and use of the applicant's medical treatment services and the registrant's cosmetics are clearly distinguishable as are the channels of trade and the points of purchase and administration associated therewith. Hence, in the distinctly different market places where the respective services and goods of the applicant and registrant will be marketed, purchased and administered, it is submitted that confusion as to the source of these services and goods is unlikely.

See Dr. Youssef August 27, 2007 Office Action Response on behalf of his application for the YOUNIQUE mark (Serial No. 77/022,914), while discussing a third-party registration for the mark YOUNIQUE & Design that, like the Yunique registration at issue here, covers make-up. (Emphasis added.)

It is difficult to imagine Dr. Youssef making a statement that more squarely contradicts the allegations in his Petition. Dr. Youssef's Petition, however, is insupportable for many other reasons as well. For example, although Dr. Youssef goes to great lengths in his Petition to characterize Yunique's trademark registration as covering the YOUNIQUE PRODUCTS word mark (*see, e.g.*, Paragraphs 2 and 3), Dr. Youssef deliberately ignores the prominent and distinctive "Swirl/Flourish" design that is located at the top of Yunique's registered mark, which is much larger in size than the "Yunique Products" text below that design. When the parties' marks are considered in their entireties, it is clear that the marks are not confusingly similar in terms of appearance or commercial

impression, and this is just one of the many additional shortcomings plaguing Dr. Youssef's Petition. In sum, for a variety of reasons, and as Dr. Youssef himself previously represented to the USPTO, there is absolutely no risk of consumer confusion here and the Petition should be denied in full.

Dr. Youssef's Petition is particularly offensive considering that, as discussed in the Counterclaims below, Dr. Youssef has fraudulently prosecuted his YOUNIQUE trademark application alleged in his Petition (Serial No. 86/446,733). Specifically, through a series of knowingly false statements in his use-based application for the YOUNIQUE mark, and in order to improperly broaden his rights in that mark, Dr. Youssef has willfully misled the USPTO and stated that he is currently using the YOUNIQUE mark in United States commerce in connection with a multitude of products for which Dr. Youssef has in fact never used the YOUNIQUE mark. In accordance with well-established Trademark Trial and Appeal Board ("TTAB") caselaw, and because Dr. Youssef's willful falsities implicate all classes and categories of goods in his application, Dr. Youssef's pending application for the YOUNIQUE mark should be withdrawn and cancelled in its entirety.

ANSWER

All allegations (including any assumptions or predicates included in Petitioner's allegations) that are not expressly admitted are hereby denied. Without waiving any right, Yunique answers the allegations in the Petition as follows:

1. Regarding Paragraph 1, Yunique states that the materials on file with the USPTO speak for themselves, and to the extent that such materials are silent regarding the allegations in Paragraph 1 or contradict such allegations, and/or to the extent that discovery in this matter or other background facts contradict such allegations, Yunique denies such allegations.

2. Regarding Paragraph 2, Yunique admits that it owns Reg. No. 4,504,512 and that this registration covers "make-up" in Class 3. Yunique denies that the registered mark is "YOUNIQUE PRODUCTS" as alleged in the Petition, as this characterization ignores the

prominent and distinctive “Swirl/Flourish” design that is located at the top of the registered mark and that is much larger in size than the “Younique Products” text below that design.

3. Regarding Paragraph 3, Younique admits that as of the date of this filing, USPTO records for Reg. No. 4,504,512 recite an address for Younique in Pleasant Grove, Utah, and that this registration covers “make-up” in Class 3. Younique denies that its current business address is in Pleasant Grove, Utah, and Younique anticipates that its address information will be updated in USPTO records in due course to reflect Younique’s current business address in Lehi, Utah. For the reasons discussed in Paragraph 2 above, Younique denies that the registered mark is “YOUNIQUE PRODUCTS” as alleged in the Petition.

4. Regarding Paragraph 4, Younique states that the materials on file with the USPTO speak for themselves, and Younique admits that its Reg. No. 4,504,512 includes the statement that “No claim is made to the exclusive right to use ‘Products’ apart from the mark as shown.” Younique denies the allegation in Paragraph 4 that “Registrant was required by the Patent and Trademark Office to include [this statement] as a limitation to its registration.”

5. Younique denies the allegations set forth in Paragraph 5 in the Petition.

6. Regarding Paragraph 6, Younique admits that Reg. No. 4,504,512 covers “make-up.” Younique denies all other allegations in Paragraph 6.

7. Regarding Paragraph 7, Younique states that the materials on file with the USPTO speak for themselves, and to the extent that such materials are silent regarding the allegations in Paragraph 7 or contradict such allegations, and/or to the extent that discovery in this matter or other background facts contradict such allegations, Younique denies such allegations.

8. Regarding Paragraph 8, Younique admits that Reg. No. 4,504,512 includes First Use and First Use in Commerce dates of July 1, 2012 and November 1, 2012, respectively.

9. Younique denies the allegations set forth in Paragraph 9 in the Petition.

10. Regarding Paragraph 10, Yunique states that the materials on file with the USPTO speak for themselves, and to the extent that such materials are silent regarding the allegations in Paragraph 10 or contradict such allegations, and/or to the extent that discovery in this matter or other background facts contradict such allegations, Yunique denies such allegations.

11. Yunique is not required to and makes no answer as to the legal conclusions set forth in Paragraph 11 in the Petition. To the extent an answer is required, Yunique denies all allegations in Paragraph 11.

12. Regarding Paragraph 12, Yunique admits that Petitioner seeks cancellation of Reg. No. 4,504,512 in this proceeding, but Yunique denies that Petitioner is entitled to this relief, and Yunique denies that Reg. No. 4,504,512 should be cancelled for any reason.

13. Yunique denies the allegations set forth in Paragraph 13 in the Petition.

14. Yunique is not required to and makes no answer as to the legal conclusions set forth in Paragraph 14 in the Petition. To the extent an answer is required, Yunique denies all allegations in Paragraph 14.

AFFIRMATIVE DEFENSES

Yunique, without assuming any burden of proof that it would not otherwise bear under applicable law, and still urging and relying on matters already alleged in this Answer, further alleges by way of the following affirmative defenses:

First Defense

The Petition fails to state a claim against Yunique upon which relief can be granted.

Second Defense

There is no likelihood of consumer confusion.

Third Defense

Petitioner's alleged YOUNIQUE trademark is used in a sufficiently crowded field by third-parties and without objection by Petitioner. Accordingly, Petitioner's mark is too weak to preclude Younique's registration of the YOUNIQUE PRODUCTS & Design trademark.

Fourth Defense

Petitioner has failed to enforce its claimed YOUNIQUE mark against other third-party users, resulting in an abandonment of any trademark rights.

Fifth Defense

Petitioner's claims are barred because of Petitioner's unclean hands and Petitioner's fraudulent conduct.

Sixth Defense

Petitioner is precluded from asserting its claims under the equitable doctrines of laches, waiver, and estoppel.

Seventh Defense

Younique's actions at all times were reasonable, justified, and undertaken in good faith, and Younique did not directly or indirectly undertake or fail to undertake any action in violation of the law.

Eighth Defense

Petitioner's claims are barred in whole or in part by the principles of consent, acquiescence, and/or legal justification.

Ninth Defense

Petitioner's claims are barred because these claims have been filed for an improper purpose and lack a reasonable and good faith basis in fact.

Tenth Defense

Petitioner's claims are barred by Petitioner's express or implied agreements, knowledge, promises, or permission.

RESERVATION OF RIGHTS

Younique reserves the right to rely on any statutory defenses pursuant to Sections 2, 14, and 33 of the Lanham Act to the extent that such defenses are supported by information developed through discovery or by evidence at a hearing before the TTAB. Younique also reserves the right to rely on all matters constituting an avoidance or defense pursuant to Rule 8(c) of the Federal Rules of Civil Procedure or otherwise to the extent such defenses are supported by information developed through discovery or by evidence at a hearing before the TTAB.

Younique also hereby gives notice that it intends to rely upon such other and further affirmative defenses and counterclaims as may become available during discovery in this action and reserves the right to amend its Answer to assert any such defenses, and its Counterclaims to add any such counterclaims.

COUNTERCLAIM

(Withdrawal and Cancellation of Serial No. 86/446,733 for the YOUNIQUE Trademark)

15. Younique realleges its Preliminary Statement, Paragraphs 1 through 14 of its Answer, all of its Affirmative Defenses, and its Reservation of Rights above, and incorporates all such content by reference as if fully set forth herein.

16. According to USPTO records, Petitioner is the owner of Serial No. 86/446,733 covering the YOUNIQUE mark ("Petitioner's Application").

17. Petitioner's Application covers only various "non-medicated cosmetics" in Class 3 and various "cosmetics containing a medication" in Class 5. There are no other Classes in Petitioner's Application.

18. Petitioner has asserted Petitioner's Application against Younique in this proceeding.

19. Younique has been and will continue to be damaged by Petitioner's Application, and hereby petitions for Petitioner's Application to be withdrawn and cancelled in its entirety, as the manner in which Petitioner has prosecuted this application constitutes a fraud on the USPTO.

20. When Petitioner filed Petitioner's Application on November 6, 2014 ("Petitioner's Application Filing"), Petitioner represented to the USPTO that Petitioner was currently using the YOUNIQUE mark in United States commerce in connection with **all** of the following goods in Class 3: "Non-medicated cosmetics, namely, facial cleansers, skin moisturizing creams, lotions and toners, facial masks and scrubs, anti-bruising gels and creams, makeup, makeup remover, skin foundation, eye cream and eyelash conditioner."

21. Petitioner also represented to the USPTO in Petitioner's Application Filing that Petitioner was currently using the YOUNIQUE mark in United States commerce in connection with **all** of the following goods in Class 5: "Cosmetics containing a medication, namely, facial cleansers, skin moisturizing creams and lotions, acne creams and pre-saturated pads containing acne medication, liquid eyelash conditioners and growth enhancers, skin lightening creams, post-laser burn creams, sun block and sun screen liquids, eye creams, facial masks, shaving cream and skin bleaching creams."

22. As of today's date, all of the "non-medicated cosmetics" and "cosmetics containing a medication" recited in Paragraphs 20 and 21 above remain within the covered goods in Petitioner's Application.

23. However, on information and belief, Petitioner has **never** used the YOUNIQUE mark in United States commerce in connection with many of the "non-medicated cosmetics" and "cosmetics containing a medication" included within Petitioner's Application.

24. For example, on information and belief, Petitioner has **never** used the YOUNIQUE mark in United States commerce in connection with the following products, all of which were

included in Petitioner's Application Filing and remain in Petitioner's Application as of today's date: "facial masks," "anti-bruising gels and creams," "makeup," "skin foundation," "eyelash conditioner" (all of the preceding goods in Class 3), "liquid eyelash conditioners and growth enhancers," "post-laser burn creams," "sun screen liquids," "facial masks," "shaving cream," and "skin bleaching creams" (all of the preceding goods in Class 5).

25. Furthermore, on information and belief, even if Petitioner had previously used the YOUNIQUE mark in United States commerce in connection with any of these products at some point in the past, Petitioner was no longer using the YOUNIQUE mark in connection with these products when Petitioner represented to the USPTO in Petitioner's Application Filing that Petitioner was currently using the YOUNIQUE mark in connection with all such products.

26. On information and belief, Petitioner knew when he made Petitioner's Application Filing that he had not previously and was not currently using the YOUNIQUE mark in United States commerce in connection with these products, and Petitioner included these knowing misstatements in order to broaden his federal trademark rights for the YOUNIQUE mark.

27. Petitioner's misrepresentations were fraudulently and knowingly asserted.

28. Petitioner's statements are willfully false, without excuse, concern material representations, and demonstrate a reckless disregard for the truth.

29. Petitioner's actual deceptive intent and reckless disregard may be inferred from the clear and convincing evidence in this matter.

30. It is expected that discovery will reveal additional evidence of an intent to deceive the USPTO.

31. Petitioner's knowingly false, willful, material, and fraudulent representations concern all Classes included within Petitioner's Application.

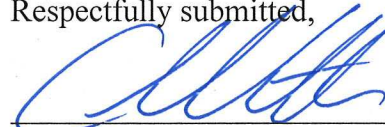
32. Petitioner's knowingly false, willful, material, and fraudulent representations have tainted the entire application process for Petitioner's Application and cannot be cured by subsequent events during the application process.

33. As a result of Petitioner's knowingly false, willful, material, and fraudulent representations, and based on established TTAB caselaw, Petitioner's Application should be withdrawn and cancelled in its entirety.

WHEREFORE, Younique respectfully prays that Petitioner's Petition for Cancellation be dismissed in its entirety; that Younique's Counterclaims be sustained and Petitioner's U.S. Serial No. 86/446,733 be withdrawn and cancelled in its entirety; that the Board enter judgment against Petitioner and in favor of Younique; and that the Board award any other relief against Petitioner that is equitable or appropriate under the circumstances, including as permitted by 15 U.S.C. § 1068. Younique has authorized that all applicable fees for these Counterclaims be deducted from its undersigned counsel's Deposit Account.

Date: September 29, 2015

Respectfully submitted,



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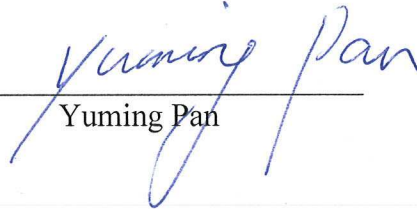
*Attorneys for Registrant and Counterclaimant
Younique, LLC*

CERTIFICATE OF SERVICE

The undersigned does hereby certify that on September 29, 2015, a true and correct copy of the foregoing Registrant's Answer, Affirmative Defenses, and Counterclaims was served by overnight courier on counsel for Petitioner/Counterdefendant as follows:

Morland C. Fisher
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September 29, 2015



Yuming Pan